

**REMARKS**

Claims 1-17, 19, 21-24, 26, 30 and 31 are pending in the application. Claims 18, 20, 25 and 27-29 are cancelled. Claims 1-4, 6-9, 11, 12, 16, 17, 21-24 and 26 are amended. Claims 30 and 31 are new. No new matter is added.

Claims 4, 12-29 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4 and 24 have been amended to provide for proper antecedent basis. Claim 12 has been amended to eliminate the “and/or” language. Applicants request that the Examiner withdraw the rejection.

Claims 1 and 3 are objected due to, respectively, to a spelling error and an unclear phrase. Claims 1 and 3 have been amended to eliminate the spelling error and clarify the language. Applicants request withdrawal of the objections.

Claims 12-14, 16-22, and 27-28 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,952,213 (“Bowman”). Applicant traverses the rejection.

Claim 12 claims a device for guiding an instrument when performing an invasive procedure on an extremity of a bone that includes a fixing block configured to be attached to the extremity of the bone in a fixing plane; a guiding block mountable on the fixing block substantially in the fixing plane, the *guiding block defining a guiding path having a path axis that is substantially perpendicular to the fixing plane*; and a first manipulator operatively connected to the fixing block and the guiding block for pivoting the guiding block with respect to the fixing block *about an axis substantially perpendicular to the fixing plane*, wherein the first manipulator is manipulable from a position at or near to a transverse end of the device.

Bowman fails to describe the invention of claim 12. First, Bowman fails to describe a guiding block that defines a guiding path having *a path axis that is substantially perpendicular to the fixing plane*. Referring to annotated Figure 1 of Bowman on page 8 of the Office Action,

Bowman describes a system where the path axis of the guiding path is parallel to the fixing plane rather than being perpendicular thereto. As claimed, the fixing block is configured to be attached to the extremity of the bone in the fixing plane. The lower surface of the fixing block is attached to the extremity of the bone, which defines the fixing plane. Turning to Figure 4 of Bowman, once the relatively complex apparatus that connects the saw guide assembly 24 to intramedullary rod 40 is removed, the saw guide assembly 24 (along with guide plate 184) define a slot whose plane is parallel to the fixing plane. As a result, the guiding path of Bowman does not describe a path axis that is substantially perpendicular to the fixing plane.

Second, Bowman fails to describe a first manipulator operatively connected to the fixing block and the guiding block for pivoting the guiding block with respect to the fixing block *about an axis substantially perpendicular to the fixing plane*. The Examiner points to element 84 of Bowman as describing such an element. The Examiner, however, appears to be equating a fixing axis with a fixing plane. As described above the **fixing plane** is defined by the plane of the bone (upon which the fixing block is attached). The pivot axis of element 84 of Bowman is parallel to the fixing plane of Bowman rather than being substantially perpendicular as required by claim 12.

Thus Bowman fails to describe the claimed invention for at least these two reasons, and Applicant therefore requests that the rejection be withdrawn with respect to claim 12, and with respect to those claims that depend from claim 12 (which are themselves patentable over Bowman).

Claims 1-3, 5-6, and 9-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bowman in view of U.S. Patent Application Publication No. 2002/0161374 ("Cohen"). Applicant traverses the rejection.

Claim 1 claims an apparatus for guiding a cutting tool in a surgical procedure on a bone that includes a fixation block configured to be attached to a bone in a fixing plane; a guide block attached to the fixation block, the guide block defining a path for a cutting tool, the path having a path axis that is substantially perpendicular to the fixing plane; wherein the guide block is (i) translatable relative to the fixation block along a translation axis substantially parallel to the

fixing plane, and (ii) pivotable relative to the fixation block about a pivot axis that is substantially parallel to the path axis; and wherein the pivotable connection between the guide block fixation block is a worm drive assembly.

As described above in connection with claim 12, Applicant submits that Bowman fails to describe elements claimed in claim 1. First, Bowman does not describe a guide block that defines a path for a cutting tool that has a path axis that is substantially perpendicular to the fixing plane. Instead, as described above, the path axis is substantially parallel to the fixing plane in Bowman. Second, Bowman does not describe a guide block that is pivotable relative to the fixation block about a pivot axis that is substantially parallel to the path axis. Instead, the pivot axis of element 84 of Bowman is perpendicular to the path axis defined by saw guide assembly 24.

Third, Bowman does not describe that the claimed pivotable connection is a worm drive assembly. The Examiner admits that Bowman does not describe a worm gear, but suggests that Bowman describes a spring locking pin and that such an element is an equivalent to a worm gear because Cohen states as such. Cohen states that one skilled in the art would recognize that an “expansion means” could use “other mechanisms, either alone or in combination, such as, for example, ratchets, worm-screws, sliding devices, *unidirectional sliding devices* bidirectional sliding devices, multi-vector sliding devices, rack and pinion devices *worm gears* and the like ...”. See paragraph [0043] of Cohen. Thus, the Examiner equates a spring locking pin with a unidirectional sliding device in the Office Action, and then concludes that because Cohen describes that a unidirectional sliding device could be used as an expansion means or alternatively a worm gear could be used as an expansion means, that a unidirectional sliding device is equivalent to a worm gear and thus a worm gear is interchangeable with a spring locking pin.

Applicant submits that such reasoning is hind sight reasoning and does not withstand scrutiny. The spring locking pin does not perform the function of the claimed worm drive assembly, nor does a unidirectional sliding device. Simply because a unidirectional sliding device is listed in the same paragraph as a potential “expansion means” with a worm gear does not

mean that a unidirectional sliding device and a worm gear are equivalent or interchangeable, let alone that a worm gear and a spring locking pin are equivalent or interchangeable. Applicants submit that the Examiner has failed to meet the prima facie burden on this element, and that neither Bowen nor Cohen describe the claimed elements of claim 1, nor the elements of the claims that depend from claim 1. As a result, Applicants request the withdrawal of the rejection.

Claims 4, 7-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bowman in view of Cohen in further view of U.S. Patent No. 7,547,307 ("Carson"). Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Bowman. Claims 23-26, and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bowman in view of Carson. Those claims that depend from the independent claims are patentable at least because they depend therefrom. For the sake of brevity, Applicant will not describe how Bowman fails to describe each element of the dependent claims, instead relying for now on the fact that the dependent claims depend from independent claims that Applicant submits are patentable over Bowman and over any combination with Cohen or Carson.

Applicants submit that claims 30 and 31 describe further patentable inventions, and request that they be indicated as allowable.

Please charge any fee associated with the prosecution of this application to Deposit Account No. 10-0750. Applicants submit that the application is presently in condition for allowance and request favorable reconsideration and early notice of allowance. If it would speed prosecution, the Examiner is encouraged to contact the undersigned attorney by telephone.

Respectfully submitted,

/Brian S. Tomko/

By: \_\_\_\_\_

Brian S. Tomko  
Reg. No. 41349

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-1239  
Dated: December 18, 2009